



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-----------------------|---------------------|------------------|
| 10/084,291      | 02/27/2002  | Christopher P. Carson | 50642/270979        | 6664             |

30559 7590 10/21/2005

CHIEF PATENT COUNSEL  
SMITH & NEPHEW, INC.  
1450 BROOKS ROAD  
MEMPHIS, TN 38116

EXAMINER

SMITH, RUTH S

ART UNIT PAPER NUMBER

3737

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/084,291

Applicant(s)

CARSON, CHRISTOPHER P.

Examiner

Ruth S. Smith

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 12-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/02, 8/02, 10/02</u> | 6) <input checked="" type="checkbox"/> Other: <u>IDS 1/03, 11/03, 4/04, 9/05</u>        |

### ***Election/Restrictions***

Applicant's election with traverse of the invention of Group I in the reply filed on June 10, 2005 is acknowledged. The traversal is on the ground(s) that the examiner has failed to show that a burden exists in examining both groups due to both groups being classified in the same class/subclass. This is not found persuasive because the search for both groups is not the same.

The requirement is still deemed proper and is therefore made FINAL.

Claims 12-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on June 10, 2005.

### ***Specification***

The disclosure is objected to because of the following informalities: On page 15, line 5, the third US Patent No. cited is incomplete. Appropriate correction is required.

### ***Claim Objections***

Claims 1-11 are objected to because of the following informalities: In claims 1, 10, step c, it is unclear as to whether applicant is referring to the sensor set forth in step a or step b. It should be noted that step b sets forth a sensor that is not necessarily the same sensor set forth in step a. In claim 6, "the position tracking sensors" lacks antecedent basis. Claim 8 is confusing in that claim 1 fails to set forth the instrument as being "installed". In claim 8, it is unclear as to whether the drill sleeve is in addition to the surgical instrument set forth in claim 1 or further defines the instrument set forth in claim 1. Claims 10,11 are confusing in that the claims fail to initially set forth the instrument as being "installed". Claim 9 is confusing in that it implies that the computer "tracks fiducials", however, the computer is merely set forth as tracking the surgical instrument relative to the body part. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

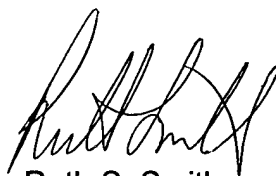
Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brosseau et al (WO 99/60939) in view of Bucholz et al (6,236,875). Brosseau et al disclose a process of performing surgery on the knee. An image is obtained using an imager which can comprise an MRI or CT scanner, an instrument having an attached fiducial marker is used and markers are also attached to the tibia and femur. The position of the markers is detected by a position sensing system which can comprise a well known type of position and orientation tracking system such as a magnetic tracking system as is well known in the art. Brosseau et al fails to disclose attaching a fiducial marker to the imager as well as the instrument and body parts. Bucholz et al discloses a computer assisted surgical system having fiducials used to track the position of the imager in the system in order to determine the track the position of the imager relative to the body part being imaged. It would have been obvious to one skilled in the art to have modified Brosseau et al such that the imager also includes fiducials attached thereto in order to properly register the images with the body part being imaged by the imager. With respect to claim 7,8, the specific instrument used would have been an obvious design choice based upon the specific type of surgical procedure being performed. The use of such instruments are well known in the art for performing a surgical procedure on the knee. With regard to claim 9,11, the specific tests performed on the knee to assess the process would have been an obvious design choice of known equivalents in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth S. Smith whose telephone number is 571-272-4745. The examiner can normally be reached on M-F 7:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3737

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Ruth S. Smith', with a stylized, cursive script.

Ruth S. Smith  
Primary Examiner  
Art Unit 3737

RSS